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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 565

EDWARD FREDKIN, *Petitioner*

v.

EUGENE H. IRASEK

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

The petitioner, Edward Fredkin, prays that a writ of certiorari issue to review the final judgment of the United States Court of Customs and Patent Appeals entered in this case on June 27, 1968.

OPINION

The opinion of The Court of Customs and Patent Appeals appears as Item 3 of the Transcript herein and is reported at 158 U.S.P.Q. 280; and only the pertinent portions thereof for purposes of this petition and the sole issue raised thereby are reproduced herein (App. *infra*, p. 1a).

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on June 27, 1968. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

QUESTION PRESENTED

Now that it is an Article III Court, is the Court of Customs and Patent Appeals *powerless,* as it has specifically held in this case, to protect the public by preventing the issuance of an admittedly invalid patent claim to one party because the other party to a patent interference failed in the early stages of the interference to present reasons for such invalidity; or, do the public interest, jurisdiction and duty of an Article III Court require the intervention of that Court whenever the invalidity of a claim is patently demonstrated?

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, Section 8, clause 8, of the Constitution of the United States provides:

> The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

28 U.S.C. 1256 provides:

> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

35 U.S.C. 101 provides:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of

matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 112 provides:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

STATEMENT OF THE CASE

This cause involves an attempt by The National Cash Register Company, assignee of the patent application of the respondent Irasek (Trans. of Record, p. 4) to take away from your petitioner Fredkin, assignor to a small science-based company, Bolt Beranek & Newman, Inc., by way of patent interference proceedings in the Patent Office, a patent (Transcript of Record p. 177) that had been issued by the Patent Office to your petitioner.

Although the challenged patent and the interference application cover complicated auxiliary equipment for use with computers and the like, the *technology is irrelevant for purposes of this petition and no technical understanding or issue* is involved herein.

The question is merely whether The National Cash Register Company may be awarded a patent claim

(claim 4)[1] to which the findings of the Court show it is not entitled because the subject matter is not disclosed in the Irasek application,[2] merely because of the technicality that Fredkin, through what the Court found to be 'a misunderstanding', did not, in the early stages of the interference, call the attention of the Patent Office to this lack of disclosure in the Irasek application.

In other words, though the Court of Customs and Patent Appeals *now* knows that, claim 4 unequivocally specifies a "magnetic coupling", and that The National Cash Register Company even admits that the Irasek application contains no disclosure of a "magnetic coupling", the Court has held that it is powerless, as it construes its jurisdiction and duty, to prevent the awarding of that claim to The National Cash Register Company merely because Fredkin, through 'misunderstanding', did not call attention to this fact early in the interference proceedings in the Patent Office.

The Court's specific findings were (App., *infra*):

a) Claim 4 specifies "said coupling means *being magnetic*".

b) All that the Irasek application admittedly discloses is "an electromagnet to turn card-holding rods", not even a "coupling".

---

[1] Claim 4 (count 4 of the interference), reads: "4. The apparatus of claim 1, *said coupling means being magnetic.*" (Transcript of Record, p. 185).

A similar holding was also made with regard to count 3.

[2] 35 U.S.C. 112, *supra*, requires disclosure in "full, clear, concise, and exact terms" to obtain a patent claim.

c) "Irasek answered negatively as to whether he disclosed 'magnetic, as distinguished from electromagnetic, coupling means . . ."

And then, the most startling assertion:

d) "that Irasek will obtain a patent with an *invalid claim . . . is not a matter which can be considered here. Kleinman* v. *Steinbach,* 38 CCPA 924, 187 F. 2d 743, 89 USPQ 151 (1951)."

Your petitioner fails to find authority in the *Kleinman* case or any other case, that invalidity of a patent claim "is not a matter which can be considered" by an Article III appellate court!

REASONS FOR GRANTING THE WRIT

This Supreme Court has made plain in *Brenner* v. *Manson,* 383 U.S. 519, 148 U.S.P.Q. 689 (1966), that a decision of the Court of Customs and Patent Appeals

"is that of an Article III court. It is 'judicial' in character";

and that 28 U.S.C. 1256

"authorizes the grant of certiorari".

1. It is, accordingly, believed to be imperative for this Supreme Court to determine promptly whether such an Article III court possesses *less* jurisdiction and duty than all other Article III courts, which this Supreme Court has consistently charged with the task of continually determining validity of claims as a matter of great "public importance", *Sinclair Co.* v. *Interchemical Corp.,* 325 U.S. 327, 330 (1944).

This mandate from the Supreme Court continually to determine and act on invalidity has been followed by all other Article III courts throughout the land, except for the Court of Customs and Patent Appeals which, as above quoted, seems to feel it has no power, as in the present case, to prevent issuance of an invalid patent claim unless this matter had been raised from the very beginning in the Patent Office.

Thus, for example, in the 2nd Circuit, the courts follow this mandate, *Addressograph-Multigraph Corp.* v. *Cooper,* 156 F. 2d 483, 485 (2 Cir., 1946):

> "The reason for this is the importance to the public generally that an invalid patent 'should not remain in the art as a scarecrow.' *Bresnick* v. *United States Vitamin Corp.,* 2 Cir., 139 F. 2d, 239, 242."

Only the Court of Customs and Patent Appeals, among all the Article III appellate courts of the land thus feels that invalidity is a question that cannot even "be considered" by the court on its own.

And when it is remembered that the Court of Customs and Patent Appeals is in the unique position of being the *only* appellate court from the Patent Office, and the very court, accordingly, that authorizes the grant of thousands of patents, the importance of the prompt resolution of its powers and duties in this particular, is made all the more evident.

In the above-mentioned *Brenner* v. *Manson* case, moreover, this Supreme Court almost informed the Court of Customs and Patent Appeals of its duty in the premises; but not quite. Specifically, in footnote (12), this Supreme Court reiterated the duty of the

patent examiner to determine patentability before declaring an interference, stating

> "the examiner, 'before the declaration of an interference' must determine the patentability of the claim *as to each party.*" (emphasis supplied).

But the Supreme Court did not go on to say that, during the interference, the Court of Customs and Patent Appeals is charged with a similar duty, particularly if, on the face of the record, it appears that a claim would be invalid if issued in one party's patent.

It is urged that the time has come so to instruct the Court of Customs and Patent Appeals lest the highly undesirable result continue that patents be spawned with clearly invalid claims—the "scarecrow" patents referred to in the *Addressograph* case, *supra.*

2. This Court will take judicial notice of the dominant position of The National Cash Register Company in the field in question, and should properly share the concern of your petitioner (and presumably the rest of the computer industry) as to the improper monopolistic effect of placing in the hands of such a dominant corporation an invalid instrument for restraining commerce—a practice long condemned by this Supreme Court as violative of our anti-trust laws, *Standard Sanitary Mfg. Co.* v. *United States,* 226 U.S. 20; *Carbice Corp.* v. *American Patents Development Corp., et al.,* 283 U.S. 27, 34 (1931); and, at the very least, an improper instrument that would certainly, by its effect, have the "tendency towards monopoly" condemned by the Supreme Court in *United States* v. *DuPont & Co.,* 366 U.S. 316, 325-6.

And the irony is that this improper patent which would be used in violation of the anti-trust laws is an

instrument that the Court of Customs and Patent Appeals would have itself decreed should be issued!

It certainly appears to be an urgent matter to clarify whether such court-sanctioned invalid patents must continue to be spawned under what your petitioner believes to be a clearly erroneous interpretation by the Court of Customs and Patent Appeals as to its powers and duties, particularly now that it is an Article III court.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this petition for a writ of certiorari should be granted.

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APPENDIX

Portions Only of Opinion Pertinent to This Petition

Complete Opinion is Item 3 of Transcript of Record and Proceedings

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1967.

Patent Appeal No. 7986.

Interference No. 94,210.

EDWARD FREDKIN, *Appellant,*

v.

EUGENE H. IRASEK, *Appellee.*

June 27, 1968

WORLEY, *Chief Judge.*

Fredkin appeals from the decision of the Board of Patent Interferences awarding Irasek priority of invention in an interference between Fredkin patent No. 3,105,593[1] and an Irasek application.[2] Fredkin, as the junior party, has the burden of proving his case by a preponderance of the evidence.

The interference involves five counts corresponding to claims 1-5 of the Fredkin patent. The issues include whether the board erred in holding that the evidence Fredkin relies on to prove conception as to all the counts, and reduction to pracice as to counts 1, 2 and 5, prior to the Irasek filing date was inadequate.[3] Also in dispute is

---

[1] Issued October 1, 1963 on an application filed September 19, 1960.

[2] Serial No. 12,032, filed March 1, 1960.

[3] Since those holdings were determinative of the priority question, the board did not consider Irasek's evidence of conception and reduction to practice prior to his filing date.

whether the board erred in holding that Fredkin was precluded from questioning the support in the Irasek application for certain recitations in counts 3 and 4.

The invention relates to apparatus for removing a selected information storage card from a stack of such cards, automatically guiding the selected card past information sensing means, and thereafter returning it to the stack. Counts 1, 3 and 4 read:

> 1. Selector apparatus having in combination, a stack of cards containing information at a predetermined position thereon, said cards having at predetermined regions thereof card-coding elements, said elements defining different patterns for the respective cards, a plurality of card-holding members adjacent corresponding coding elements and having means for releasably coupling the holding members to coding elements of said cards, code-selective operating means for preventing the coupling of coding elements of a selected card with corresponding holding members, whereby the selected card may be separated from said stack, means for automatically guiding the selected card apart from said stack along a predetermined path and thereafter returning the selected card to said stack, and information-sensing means disposed along said path in alignment with said predetermined card position for scanning the information contained on the selected card as the selected card follows said predetermined path.
>
> 3. The apparatus of count 1, said information being arranged in a plurality of parallel tracks on said cards, said sensing means having plural scanning elements aligned with corresponding tracks as the selected card is moved along said path past said scanning elements.
>
> 4. The apparatus of count 1, said coupling means being magnetic.

* * *

Fredkin also argues that Irasek has no support in his application for the limitation of "said coupling means being magnetic" in count 4. The board, pointing out

that no motion to dissolve as to count 4 was made during the motion period, ruled that the question was not before it and declined to rule thereon.

Fredkin admits that he did not include count 4 in his motion to dissolve, referring to "a misunderstanding of the Irasek disclosure." However, he urges that "Irasek himself admitted during his testimony that there simply is no disclosure in the Irasek application * * * of a magnetic coupling between a card holding member and coding elements adjacent thereto." It is Fredkin's contention that it was the duty of the board, *sua sponte*, to rule on the matter because of the alleged admission, citing *Smith* v. *Foley* v. *Anderson* v. *Smith*, 1908 C.D. 210, 136 O.G. 847 (Comr. Pat. 1907); *White* v. *Wege*, 44 App. D.C. 495, 1916 C.D. 195, 227 O.G. 1107 (1916); and *Heuberger* v. *Becker*, 27 CCPA 746, 107 F. 2d 601, 43 USPQ 404 (1939).

We think it plain that the action of the board with respect to claim 4 should not be disturbed because the issue was not raised by appropriate motion. While the cited cases indicate that the board may act *sua sponte* in certain circumstances, they also indicate that there are limitations on such action. Thus, the board is free to decline to consider a question of support which is not raised by a party even in a case where it would be appropriate for it to raise the question. As this court stated in *Heuberger* v. *Becker*, supra:

> It is clear that if the Examiner of Interferences [now Board of Patent Interferences] had not raised the question he could properly have ruled that this question would not be considered by him because of failure of appellee to raise it during the motion period.

Also, the Board could hardly have raised the present question *sua sponte* since it was in fact raised by Fredkin. See *Franklin* v. *Hopper*, supra.

It is also apparent that Irasek has not admitted that his application does not support count 4. The language in

Irasek's testimony relied on by Fredkin as admissions involve decidedly different terminology than is present in count 4. Specifically, Irasek answered negatively as to whether he disclosed "magnetic, as distinguished from electro-magnetic, coupling means *as the force between the rods supporting the cards and the notches of the cards*" [Emphasis supplied]. Irasek does disclose the use of an electromagnet to turn cardholding rods to positions releasing the cards and contends that the claim language is broad enough to cover that construction. While Fredkin expresses the fear that Irasek will obtain a patent with an invalid claim, that question is not a matter which can be considered here. *Kleinman* v. *Steinbach*, 38 CCPA 924, 187 F.2d 743, 89 USPQ 151 (1951).

* * *

The decision is *affirmed*.

AFFIRMED

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EUGENE H. IRASEK

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

There is no need or occasion for a review of the decision of the Court of Customs and Patent Appeals, reported at 397 F.2d 342. There is no conflict with other decisions, no question of general or public importance, no question of the judicial power of that Court, and no error.

The single matter that is questioned is the refusal of that Court, in reviewing a decision of the Patent Office adverse to petitioner on an issue of priority of invention, to consider also the separate question of whether or not respondent's application for patent dis-

closes the subject of the claim which was count 4 of the interference (priority) proceeding. It is asserted, on an untenable basis that was rejected below, that respondent has admitted that his application lacks that requisite disclosure. If the lack did exist, the claim of course would be invalid for lack of compliance with Section 112 of Title 35, U.S. Code. Petitioner's contention is that, because of the public interest involved in the validity of patents, the Court below should have looked into the question of respondent's disclosure, despite the fact that petitioner had failed to raise the question by the established procedure of a motion to dissolve the interference at the outset. (Patent Office Rules 231, 232 and 258).[1] Petitioner seems to assert also, but it is not the fact, that the Court's refusal was because it thought it lacked power to act.

The Primary Examiner had made the necessary threshold determination that respondent had a disclosure of the subject of count 4, because he permitted respondent to make the claim (copied from petitioner's issued patent) and he instituted the interference proceeding in order to settle the priority question, i.e., the question whether petitioner or respondent was the first inventor of that subject claimed by both. If respondent's application for patent does not disclose that subject, there would have been no need or basis for the interference proceeding. *Alpert* v. *Slatin*, 305 F. 2d 891, at 893, N. 3 (CCPA, 1962): *Brenner* v. *Manson*, 383 U.S. 519, at 528, footnote 12.

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[1] These and other Patent Office rules, as they were at the time of this interference proceeding, appear in the Appendix to this brief, together with relevant sections of Title 35 of the United States Code (Patent Act of 1952).

By such a "motion to dissolve" the interference proceeding, petitioner had questioned at the outset respondent's right to make another claim, which was count 3, but had not questioned petitioner's right to make the count 4 claim. Petitioner first sought to raise a question as to count 4 before the Board of Patent Interferences at final hearing, after testimony had been taken on the priority question. But, as the Court below said, "The Board, pointing out that no motion to dissolve as to Count 4 was made during the motion period, ruled that the question was not before it and declined to rule on it". Petitioner's Appendix, at pages 2a-3a. That was a direct application of Rule 258 of the Patent Office.

The Court also said: "We think it plain that the action of the Board with respect to claim 4 should not be disturbed because the issue was not raised by appropriate motion" (*id.*, p. 3a); and also (*id.*, p. 4a) "While Fredkin expresses the fear that Irasek will obtain a patent with an invalid claim, that question is not a matter that can be considered here", citing *Kleinman* v. *Steinbach*, 187 F. 2d 743 (CCPA, 1951) in which, on the parallel matter of a party's attempt in the Court of Customs and Patent Appeals to attack the patentability of the "count" to an opponent, the Court had said: "This is a matter for *ex parte* consideration in the Patent Office after the case is remanded to its jurisdiction" (*id.*, p. 748).

The Court of Customs and Patent Appeals has held in other cases that it has power to consider such a question of disclosure *sua sponte*, but apparently it saw no reason to take that exceptional action here. Such action is taken only when "it is clear", and when "there can be no doubt", that the party's disclosure is wanting.

Franklin v. *Hopper*, 312 F. 2d 949, at 953-4 (CCPA, 1963); *Anderson* v. *Walch*, 152 F. 2d 975, 980 (CCPA, 1946).[2]

The question about respondent's disclosure is a question of technical fact that touches the scope and the meaning of that part of count 4 which, in a certain apparatus context in the art of computers, specifies that a certain "coupling means" is "magnetic". That hinges in turn on the question whether or not respondent's disclosed electromagnetic means constitutes a magnetic coupling means in the sense of those terms in that context. Such a question inherently requires technical expertise in the art. A reviewing tribunal could not well consider it as an original question without the benefit of prior discussion and decision by the Primary Examiner, who is the one versed in the particular art and the one charged primarily with the determination of such questions both in the regular course of *ex parte* prosecution of patent applications and in *inter partes* matters on a motion to dissolve an interference proceeding.

In these circumstances, a number of reasons exist for denial of the petition.

1.

No patent containing the count 4 claim has been issued to respondent, and the decision below neither

[2] The rules of the Patent Office have a similar "fail safe" provision for the exceptional case of clear error. Thus, although under Rule 258 the Board cannot consider a question of disclosure unless the question had been raised by motion to dissolve, Rule 259 gives the Board a saving freedom to make a "recommendation" to the Commissioner of Patents, which can put the question back to the Primary Examiner.

directs nor assures nor endorses the grant of such a patent to respondent. It forecloses only the limited issue of priority of invention. See 35 U.S.C. § 144. All else, including the sufficiency of respondent's disclosure, is still open to reconsideration by the Examiner in the further *ex parte* prosecution of respondent's still pending application for patent, and in regular course it will be reconsidered after remand. See Patent Office Rule 266; and cf. *Kleinman* v. *Steinbach,* 187 F. 2d 743, at 748, 2d col. (CCPA, 1951); *in re Ruschig,* 379 F. 2d 990, at 993 (CCPA, 1967). That gives assurance of protection of the public interest by the best qualified branch of the administrative agency, the branch charged primarily with the determination of such a question. By citing *Kleinman* v. *Steinbach,* the Court below plainly showed that it contemplated such a consideration of the question in the further *ex parte* proceedings on respondent's application for patent. Petitioner's contention on the disclosure question will be available to the Examiner from the interference record, which petitioner can bring to his attention by "protest" under Patent Office Rule 291.

2.

The consideration of public interest which underlies this Court's admonition[3] that patent validity be determined in actions for infringement of patents already granted does not come to bear in a case such as this where the question touches a claim in a still pending patent application and the question therefore is still open in the Patent Office where the public interest will be protected. The refusal of the Court below to look

[3] *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U.S. 327, at 330 (1945).

into the question of respondent's disclosure was not a "last chance" to protect the public interest, and does not present a question of general or public importance warranting review by this Court.

3.

There is good reason for the disposition below and for the long established practice to which it adhered. An interference proceeding to determine a priority issue presupposes that each of the interfering parties has disclosed the subject matter of the count, just as it presupposes that that subject is a patentable novelty. 35 U.S. Code § 144; and footnote 12, at page 528, in *Brenner* v. *Manson*, 383 U.S. 519. These matters have to be determined by the Primary Examiner as threshold matters which establish that a determination of priority by the Board of Patent Interferences is needed in order to enable the Patent Office to grant the patent to the right party, the *first* inventor. Hence the established procedure requiring a motion to dissolve the interference proceeding at the outset, as a way of provoking a reconsideration of the Examiner's initial determination of these prerequisites and thereby of testing whether or not that need exists.

A sanction is needed to cause a party to raise at the outset the question of disclosure (and also the question of patentability) by that motion procedure before the Primary Examiner. The need exists in order both (a) to have the benefit of his special knowledge of the art, and (b) to avoid the great waste of time and effort that would occur in taking testimony and determining priority if the presupposed need for such a determination does not in fact exist. That needed sanction is provided by Rule 258 of the Patent Office, and by the concordant practice of the Court of Customs and Patent

Appeals which, save for the exceptional case of clear error, forbids a belated *inter partes* consideration of these threshold questions at the behest of a party who failed to present them at the proper time by a motion to dissolve. Yet if petitioner's contention were to prevail, there would be no sanction. One could wait until the evidence on priority is in and then, as here, upon seeing defeat on the priority issue, seek to oust the whole proceeding by belatedly questioning its pre-supposed and pre-determined basis. The practice adhered to below prevents that, and is necessary to an orderly administrative procedure for *inter partes* determination of issues of priority; but, as already shown, it does not foreclose the question of disclosure in the further *ex parte* proceedings.

4.

Petitioner is without basis for its assertions by which it seeks to make it seem that respondent's disclosure is clearly insufficient and that the Court's refusal to look into it therefore was in disregard of the public interest.

There has been neither an admission by respondent nor a finding by the Court that respondent did not disclose that subject. The matter stands here on the Examiner's determination that respondent did disclose it, and on respondent's consistently maintained position that he disclosed it. The Court below looked into petitioner's assertion of a contrary admission in the testimony of respondent Irasek, and found that the assertion was not supported. Petitioner misinterprets the testimony. (P. App., at pp. 3a-4a).

Further, the Court below did not find that petitioner's failure to raise the question by a timely motion to dis-

solve was the result of a "misunderstanding", on petitioner's part, of respondent's disclosure. The Court did note petitioner's assertion of a misunderstanding. The assertion, however, involves the notion that petitioner was enlightened as to respondent's disclosure by the same testimony which petitioner presented as an admission that he had not disclosed a "magnetic coupling". That is the testimony which the Court perceived was not correctly interpreted by petitioner. In effect, the Court found that the assertion of a misunderstanding has no basis.

5.

There is no basis in the opinion below for the assertion that the Court's refusal to rule on the question of respondent's disclosure was based on a refusal to recognize that it exercises judicial power when reviewing a decision of a Patent Office tribunal. See page 3, *supra*.

Respectfully submitted,

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APPENDIX

Title 35, United States Code

§ 112. Specifications

The specifications shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (July 19, 1952, c. 950, § 1, 66 Stat. 798; July 24, 1965, P. L. 89-83, § 9, 79 Stat. 261.)

§ 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant,

shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted. July 19, 1952, c. 950, § 1, 66 Stat. 801.

* * * *

§ 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case. July 19, 1952, c. 950, § 1, 66 Stat. 802.

Rules of Practice of the United States Patent Office

201. Definition, when declared. (a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent.

(b) An interference will be declared between pending applications for patent, or for reissue, of different parties when such applications contain claims for substantially the same invention, which are allowable in the application of each party, and interferences will also be declared between pending applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved, in accordance with the provisions of these rules.

(c) Interferences will not be declared, nor continued, between applications or applications and patents owned by the same party unless good cause is shown therefor. The parties shall make known any and all right, title, and interest affecting the ownership of any application or patent involved or essential to the proceedings, not recorded in the Patent Office, when an interference is declared, and of changes in such right, title, or interest, made after the declaration of the interference and before the expiration of the time prescribed for seeking review of the decision in the interference.

* * * *

205. Interference with a patent; copying claims from patent. (a) Before an interference will be declared with a patent, the applicant must present in his application, copies of all the claims of the patent which also define his invention and such claims must be patentable in the application. However, an interference may be declared after copying the claims excluding an immaterial limitation or variation if such immaterial limitation or variations is not clearly supported in the application or if the applicant otherwise makes a satisfactory showing in justification thereof.

(b) Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he

presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure, unless the claim is copied in response to a suggestion by the Office. The examiner will call to the Commissioner's attention any instance of the filing of an application or the presentation of an amendment copying or substantially copying claims from a patent without calling attention to that fact and identifying the patent.

206. Interference with a patent; claims improperly copied. (a) Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion the applicant cannot make the other claims and state further that the interference will be promptly declared. The applicant may proceed under rule 231, if he desires to further contest his right to make the claims not included in the declaration of the interference.

(b) Where the examiner is of the opinion that none of the claims can be made, he shall reject the copied claims stating in his action why the applicant cannot make the claims and set a time limit, not less than 30 days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit shall be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed will, in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

* * * *

231. Motion period. After the preliminary statements have been received and approved, or the time for filing them has expired, a period will be fixed within which the various motions specified in rules 232 to 236 may be brought by the parties. The period, not less than thirty days, will be fixed by an examiner of interferences in the notice re-

ferred to in rule 226. In the case of a junior party under order to show cause (rule 225) the period specified for answer to the order is the motion period and such motions may be brought as constitute an answer to the order.

232. Motions to dissolve. (a) Motions to dissolve an interference may be brought on the ground (1) that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) that the claims forming the counts of the interference are not patentable, or are not patentable to a particular applicant, while being patentable to another party, or (3) that a particular party has no right to make the claims, or (4) that there is no interference in fact if the interference involves a design or plant patent or application, or as to a claim included as a count under the last sentence of rule 203(a) or the last sentence of rule 205(a).

(b) When one of the parties to the interference is a patentee, no motion to dissolve may be brought by any party on the ground that the subject matter of a count is unpatentable to all parties or is unpatentable to the patentee, except that a motion to dissolve as to the patentee may be brought which is limited to such matters as may be considered at final hearing (rule 258).

(c) Motions to dissolve on the ground that the counts are unpatentable, or are unpatentable to the party bringing the motion, must be accompanied by a proposed amendment to the application of the moving party canceling the claims forming the counts of the interference, which amendment shall be entered by the primary examiner to the extent the motion is not denied, after the interference is terminated.

* * * * *

258. Matters considered in determining priority. (a) In determining priority of invention, the Board of Patent

Interferences will consider only priority of invention on the evidence submitted. Questions of patentability of a claim generally will not be considered in the decision on priority; and neither will the patentability of a claim to an opponent be considered, unless the nonpatentability of the claim to the opponent will necessarily result in the conclusion that the party raising the question is in fact the prior inventor on the evidence before the Office, or relates to matters which have been determined to be ancillary to priority and must be considered, but a party shall not be entitled to raise such nonpatentability unless he has duly presented a motion for dissolution under rule 231 upon such ground or shows good reason why such a motion was not presented.

(b) The matters raised on a motion relating to the burden of proof (rule 231) may be reviewed at final hearing.

(c) At final hearing between an application and a patent the prior art of record in the patent file may be referred to for the purpose of construing the issue.

259. Recommendation by Board of Patent Interferences. The Board of Patent Interferences may, either before or concurrently with their decision on the question of priority, but independently of such decision, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which in their opinion establishes the fact that no interference exists, or that there has been irregularity in declaring the same, or which amounts to a bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed if such matters have not been considered before by the examiner, or take other appropriate action. If the case is not so remanded, the primary examiner will, after judgment on priority, con-

sider such matters, unless the same shall have been previously disposed of by the Commissioner.

• • • •

261. Termination of interference. An interference will be terminated by judgment after final hearing (rules 251 to 259), or by judgment on the record as provided by rules 225 or 252, or by summary judgment because of an insufficient showing under rule 204(c) as provided by rule 228, or by dissolution as provided by rule 231 or rule 237, or as otherwise provided.

• • • •

266. Action after interference. (a) After the termination of the interference, the primary examiner will promptly take such action in each of the applications involved as may be necessary. Amendments presented during the interference shall not be entered except as otherwise provided; amendments required to accompany motions to amend shall be entered only to the extent the motion was granted (matter not entered may be subsequently presented by the applicant, subject to the rules relating to amendments, provided the prosecution of the application is not otherwise closed). The examiner will act on any matter requiring action and call for response to any examiner's action unresponded to.

(b) After judgment of priority, the application of any party may be held subject to further examination, including interference with other applications.

• • • •

291. Protests to the grant of a patent. The patent statutes do not provide for opposition to the grant of a patent on the part of the public. Protests to the grant of a patent are ordinarily merely acknowledged, and filed after being referred to the examiner having charge of the subject matter involved for his information.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 565

EDWARD FREDKIN, *Petitioner*

v.

EUGENE H. IRASEK

PETITIONER'S REPLY BRIEF

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PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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PETITIONER'S REPLY BRIEF

THE ACTUAL QUESTION PRESENTED

It is desired to high-light to this Honorable Court that respondent has conceded that there was, as your petitioner has stated, a

> "refusal of the Court below to look into the question of respondent's disclosure" *

to see if

> "his application lacks that requisite disclosure";

since, respondent admits,

> "If the lack did exist, *the claim of course would be invalid* for lack of compliance with Section 112 of Title 35 U.S. Code." (page 2, emphasis added.)

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* Pages 5 and 6 of respondent's brief.

While stating that respondent does not concur that the Court considered it "lacked power to act" to prevent allowance of an invalid claim (page 2), the respondent does fully agree with your petitioner, that in the "refusal of the Court below to look into the question", the Court of Customs and Patent Appeals gave as its only reason that the obtaining of

> "a patent with an invalid claim . . . . *is not a matter that can be considered here*". (page 3, emphasis supplied).

The substance of your petitioner's "Question Presented" (p. 2 of petition) thus appears to be conceded; and it remains to determine whether this issue is of sufficient importance to warrant the time of this Court.

RESPONDENT'S REASONS FOR ASSERTING NO NECESSITY FOR REVIEW BY THE SUPREME COURT

While, as above pointed out, the respondent has agreed (page 3) with your petitioner's assertion that the Court of Customs and Patent Appeals has declined *even to consider* ("not a matter that can be considered here") whether a patent claim is or is not invalid, this is justified, in respondent's view, upon four grounds:

1. The jurisdiction of the Court of Customs and Patent Appeals only runs to "the limited issue of priority of invention", citing 35 U.S.C. Sec. 144, and the matter of patentability "is still open to reconsideration by the Examiner" on remand; so that there is a "fail-safe" provision against granting the invalid claim (pages 4, 5).

2. There is no public interest since only a "pending patent *application*" is allegedly involved and not a patent (page 5).

3. To give the Court the power to pass on invalidity at any time, whether originally raised in the early interference proceedings or otherwise, would lack "orderly administrative procedure for *inter partes* determination of issues of priority".

4. This does not "disregard . . . the public interest".

The answers to these four grounds are simple.

Ground 1

As for ground 1, (namely, does the jurisdiction of the Court of Customs and Patent Appeals, as provided for in 35 U.S.C. Sec. 144 printed on page 10 of respondent's brief, run only to "the limited issue of priority of invention"), *this is precisely the issue your petitioner has raised:*

What is the jurisdiction and power of the Court of Customs and Patent Appeals?

Is it less than any other Article III Court in its inherent power and duty to pass on patent claim invalidity?

Can a court pass on so-called priority of a patent claim (who is the first inventor) while ignoring whether that patent claim is invalid so that priority could even be awarded?

As for the so-called "fail-safe" procedures, in this case the Patent Office (Board of Patent Interferences) *has also refused* to look into the matter of invalidity for lack of disclosure, since your petitioner, through "misunderstanding", had not earlier raised the issue. *The "fail-safe" is thus gone!* (They similarly refused to look into the matter with regard to count 3, which

respondent concedes, page 3, "petitioner had questioned *at the outset*", by a timely motion.)

It should be noted that the admission of the party Irasek that what he disclosed in his patent application was not a "magnetic coupling", as called for by count 4 (page 5 of petition) did not come until *long after the motion periods,* during testimony. Both the Patent Office and the Court of Customs and Patent Appeals refused to consider *such* testimony because your petitioner wasn't clairvoyant enough to anticipate it during the motion periods!!

In other words, no matter what the testimony shows, neither the Patent Office nor the Court of Customs and Patent Appeals apparently has a duty to consider the same insofar as it relates to patent claim validity, unless the matter was raised at the outset of the proceeding *before* testimony.

This squarely *raises* the most important question of petitioner:

> "Now that it is an Article III Court, is the Court of Customs and Patent Appeals *powerless,* as it has specifically held in this case, to protect the public by preventing the issuance of an admittedly invalid patent claim. . . ." (p. 2 of petition).

This appears to be a most vital question for prompt resolution, particularly since there is continued concern and conflict within the Court of Customs and Patent Appeals itself as to its powers and jurisdiction in its new Article III setting (see dispute in that Court in *Swingline Inc.* v. *Kleinert Rubber Company,* 399 F. 2d 283 (1968), 285 "this court is an Article III Court—giving rise to the obligation to act like one—".)

Ground 2

In ground 2, respondent tries to stress that only a patent "application" is involved, not a patent, so that the public interest is not involved.

Had a patent been involved, respondent appears to concede that the prior decisions of the Supreme Court make a determination of invalidity a prime task of Article III Courts.

Actually, however, a *patent* is involved, since the respondent copied the c' ims in question from the issued *patent* of petitioner, not a patent application.

Thus respondent apparently concurs with petitioner that the matter of validity of a *patent* claim is decidedly in the public interest.

Ground 3

As pointed out under ground 1, this case involves testimony that occurred *long after* the motion period; so that the material of such testimony could hardly have been anticipated or predicted earlier.

This case does not thus involve any disorderly administrative procedure.

It involves only the normal conduct of Article III courts!

Ground 4

As above shown, it is of great importance to the public to settle promptly the power, jurisdiction and duty of the Court of Customs and Patent Appeals as to invalidity of patent claims, now that it is an Article III Court.

Since this is the only appellate court from the Patent Office, the urgency is all the more evident.

It is thus respectfully submitted that the issue of this case is well worth the time of the Supreme Court to resolve.

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